REMARKS

Claims 9-23 are pending in the present application. By this Amendment, claim 9 is amended. Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

I. Formalities, allowable subject matter

Applicant thanks the Examiner for withdrawing the objections and 35 U.S.C. § 112, 1st paragraph rejections set forth in the previous Office Action, and for acknowledging foreign priority.

Additionally, Applicant notes that the rejection of claim 23 in item 9 of the June 5, 2002 Office Action has been withdrawn based on Applicant's foreign priority claim, as perfected in the October 7, 2002 Amendment. Because there is currently no ground of rejection therefor, Applicant respectfully requests indication of the allowability of claim 23.

II. Claims 9-11 and 17 are novel

Claims 9-11 and 17 stand rejected due to alleged anticipation under 35 U.S.C. § 102(e) over Kim et al. (U.S. Patent No. 5,907,379, hereafter "Kim"). Applicant respectfully submits that Kim fails to disclose all of the claimed features, as required for an anticipation rejection. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejection under §102, and allowance of the claims.

As illustrated in Figures 4-6 of Kim, a liquid crystal display (LCD) has a black matrix 3 that covers data lines 40, which the Examiner has characterized as signal lines. However, Kim does not disclose that the common electrode 20 overlaps a portion of the data lines 40 other than the portion covered by the black matrix 3.

Applicant respectfully submits that Kim fails to disclose all of the claimed combinations of features. For example, but not by way of limitation, Applicant respectfully submits that Kim fails to disclose that the black matrix overlaps first portions of the signal lines and the common electrode overlaps portions other than the first portions of the signal lines, as recited in independent claim 9. Applicant notes that Kim is distinguishable from independent claim 9 because the black matrix 3 of Kim covers substantially all of the data lines 40, such that there are no portions other than the first portion for the common electrode 20 to overlap. Thus, Applicant respectfully submits that claim 9 is novel.

Claims 10, 11 and 17 depend from independent claim 9. Applicant respectfully submits that those dependent claims are allowable for at least the same reasons as independent claim 9. Therefore, Applicant respectfully requests withdrawal of the §102 rejection, and allowance of the claims.

III. Claims 12-16 and 18-22 would not have been obvious

Claims 12-16 and 19-22 stand rejected due to alleged obviousness under 35 U.S.C. § 103(a) over Kim in view of Kondo et al. (U.S. Patent No. 6,198,520 B1, hereafter "Kondo") and claim 18 stands rejected under §103(a) over Kim and Kondo in view of Ohta et al. (U.S. Patent No. 6,064,460, hereafter "Ohta") and newly applied Yamazaki et al. (U.S. Patent No. 5,892,562, hereafter "Yamazaki"). Applicant respectfully submits that the Examiner's proposed combinations of references fail to properly disclose or suggest all of the claimed combinations of features, as required for a prima facie rejection under §103. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

Claims 12-16 and 18-22 depend from independent claim 9. Applicant respectfully submits that those claims are allowable for at least the same reasons as independent claim 9, as well as the additional reasons discussed in greater detail below.

Kondo discloses a color LCD. As illustrated in Figures 1 and 2 of Kondo, a first substrate 1 and a second substrate 1' are provided, with an LCD layer 10 sandwiched in between. On the first substrate 1, a black matrix 14 is provided, along with common electrode 2, pixel electrode 3 and signal interconnection 21. In a comparative example, Kondo discloses the black matrix 14 on the second substrate 1' in Figure 11. However, it is submitted that Figure 11 of Kondo inherits the related art problems discussed with respect to application Figures 1-4, because in Kondo, the common electrode 2 cannot electrically shield the pixel area from a voltage of the black matrix 14.

Applicant respectfully submits that the Examiner's proposed combination of references is improper for at least the reasons discussed herein.

When cited references teach away from each other, those references cannot be properly combined under MPEP §2143.01 and In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991). Accordingly, Applicant respectfully submits that Kondo and Kim cannot be properly combined to produced the claimed combinations of features. For example, but not by way of limitation, while Kondo teaches that the black matrix 14 overlaps the common electrode 2 with respect to the pixel area, Kim teaches the opposite: that the common electrode 20 overlaps the black matrix 3 with respect to the pixel area. For at least that reason, Applicant respectfully submits that the Examiner's proposed combination is improper.

Additionally, Applicant respectfully submits that Kondo would lead one skilled in the art away from the claimed invention. Applicant directs the Examiner to MPEP §2141.03 and W.L. Gore & Associates, 220 USPQ 303 (Fed. Cir. 1983). In this case, Applicant respectfully submits that the claimed invention includes a common electrode on a first substrate that electrically shields the pixel area from the voltage of the black matrix on a second substrate. Applicant submits that one skilled in the art would be led away from the claimed invention by the teachings of Kondo, because Kondo teaches the black matrix and common electrode on a single substrate at Figures 1 and 2.

In the Comparative Example of Kondo, where the black matrix and the common electrode are on opposite substrates in Figure 11, Kondo teaches that the common electrode is not positioned between the pixel area and the black matrix, as would be required for the common electrode to electrically shield the pixel area from the black matrix. Thus, it is submitted that Kondo would lead one skilled in the art away from the presently claimed invention.

For at least the foregoing reasons, Applicant respectfully submits that the Examiner's proposed combination is improper, and should be withdrawn. Accordingly, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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Date: March 25, 2003

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

9. (Amended) A method of fabricating an LCD device having a common electrode, a plurality of scanning lines, a gate insulating film, a plurality of signal lines, a plurality of pixel electrodes and a plurality of pixel areas formed on a first substrate, comprising:

patterning a black matrix on [one of the first substrate and] a second substrate; and

disposing liquid crystal between said first substrate and said second substrate, wherein said black matrix covers an area other than said pixel area and said common electrode electrically shields said pixel area from a voltage of said black matrix, and said black matrix overlaps first portions of said signal lines and said common electrode overlaps portions other than said first portions of said signal lines.